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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/867,797

Applicant(s)

YOUSTRA, WILLIAM N.

Examiner

AVI GOLD

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to the appeal brief filed on March 7, 2008. Claims 1-52 are pending.

Response to Amendment

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20, 24, 34, 38, 48, and 51 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 20, 24, 34, 38, 48, and 51 are not limited to a tangible embodiment. In view of Applicant's disclosure, specification, page 2, lines 23-25, page 4, lines 5-7, page 5, lines 8-10, and page 17, lines 3-6, the medium is not limited to tangible embodiments (i.e. propagated signal). As such, the claims are not limited to statutory subject matter and are therefore non-statutory.

Claims 24, 38, 48 and 51 are necessarily rejected as being dependent upon the rejection of claim 20 and 34.

To expedite a complete examination of the instant application the claims (20, 24, 34, 38, 48, and 51) rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 19, 20, 25, 33, 34, and 46-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds, U.S. Patent No. 6,393,465 further in view of Liu et al., U.S. Patent No. 6,760,752.

Leeds teaches the invention substantially as claimed including methods and system for handling electronic mail messages (see abstract).

As to claims 1, 19, and 20, Leeds teaches a method, apparatus, and computer program for transmitting electronic data, comprising:

receiving, at a communications system host, electronic data transmitted from a sender and addressed to an intended recipient (col. 3, line 65 – col. 4, line 1, Leeds discloses messages from a sender scanned and parsed at a server prior to delivery to a recipient);

endorsing the electronic data based on attributes of the electronic data (col. 4, lines 3-7, Leeds discloses a message being parsed and given a confidence rating); and

modifying the electronic data with endorsement information (col. 4, lines 3-7, Leeds discloses the confidence rating being assigned to the message).

Leeds fails to teach the limitation further including where the presentation of the electronic data visually distinguishes endorsed messages from nonendorsed messages.

However, Liu teaches a method and system for providing secure data transmissions between Internet users (see abstract). Liu teaches the use of a private title placeholder and visual indicators for secure messages (col. 25, lines 1-26, col. 27, line 38 – col. 28, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leeds in view of Liu to use a presentation of the electronic data that visually distinguishes endorsed messages from nonendorsed messages. One would be motivated to do so because it is an efficient way to let a user know a message is endorsed.

Regarding claims 25, 33, and 34, Leeds teaches a method, apparatus, and computer program for receiving electronic data transmitted from a sender to an intended recipient through a communications system, the communications system endorsing the electronic data based on attributes of the electronic data, the method comprising:

receiving, from a communications system host, information indicating that the electronic data has been endorsed (col. 3, line 65 – col. 4, line 7); and

rendering the information to a user of the intended recipient so as to inform the user of the intended recipient that the electronic data has been endorsed (col. 3, line 65 – col. 4, line 7).

Leeds fails to teach the limitation further including where the presentation of the electronic data visually distinguishes endorsed messages from nonendorsed messages.

However, Liu teaches the use of a private title placeholder and visual indicators for secure messages (col. 25, lines 1-26, col. 27, line 38 – col. 28, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leeds in view of Liu to use a presentation of the electronic data that visually distinguishes endorsed messages from nonendorsed messages. One would be motivated to do so because it is an efficient way to let a user know a message is endorsed.

Regarding claims 46-51, Leeds and Liu teach the method, apparatus, computer program, and graphical user interface of claims 1, 19, 20, 25, 33, and 34, wherein modifying the electronic data includes displaying both the endorsed messages and nonendorsed messages in a single display concurrently (Liu, col. 25, lines 1-26, col. 27, line 38 – col. 28, line 3).

4. Claims 2, 3, 5-7, 9-15, 17, 22, 23, 26, 27, 29-31, 36, 37, 40, 41, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds and Liu further in view of Drummond et al., U.S. Patent No. 6,691,156.

Leeds teaches the invention substantially as claimed including methods and system for handling electronic mail messages (see abstract). Liu teaches the invention

substantially as claimed including a method and system for providing secure data transmissions between Internet users (see abstract).

Regarding claim 2, Leeds teaches the method of claim 1.

Leeds fails to teach the limitation further, wherein endorsing comprises identifying the sender of the electronic data.

However, Drummond teaches the invention as claimed including techniques for restricting delivery of unsolicited e-mail, commonly known as "spam" (see abstract). Drummond teaches a sending address approved for delivery (col. 3, lines 6-10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leeds in view of Drummond to use identify a sender by a screen name. One would be motivated to combine Leeds and Drummond because it allows for a simple and effective way of restricting unsolicited e-mail within an enterprise e-mail environment (Drummond, col. 2, lines 18-20)

Regarding claim 3, Drummond teaches the method of claim 2 wherein the sender is identified by a screen name (col. 3, lines 6-10, Drummond discloses a sending address).

Regarding claim 5, Drummond teaches the method of claim 1 wherein endorsing further comprises designating a level of security corresponding to the sender of the

electronic data (col. 7, lines 45-62, Drummond discloses more difficult talks for acknowledgement to be accepted).

Regarding claim 6, Drummond teaches the method of claim 1 wherein endorsing further comprises verifying that at least one attribute of the electronic data is an attribute of an authorized sender (col. 2, lines 37-56).

Regarding claim 7, Drummond teaches the method of claim 2 wherein the attribute comprises a screen name (col. 3, lines 6-10).

Regarding claim 9, Drummond teaches the method of claim 1 wherein endorsing further comprises designating a level of security corresponding to at least one attribute of the electronic data (col. 7, lines 45-62).

Regarding claim 10, Drummond teaches the method of claim 1 further comprising:

storing content of the electronic data in a first storage area of the communications system host (col. 2, lines 37-56, Drummond discloses email stored in a holding queue); and

storing attributes of the electronic data in a second storage area of the communications system host (col. 2, lines 37-56, Drummond discloses an approved address list).

Regarding claim 11, Drummond teaches the method of claim 1 further comprising presenting the endorsement information to the intended recipient (col. 2, lines 37-56).

Regarding claim 12, Drummond teaches the method of claim 1 wherein the endorsement information is presented with the attributes of the electronic data (col. 2, lines 37-56).

Regarding claim 13, Drummond teaches the method of claim 11 wherein the endorsement information is presented with the content of the electronic data (col. 2, lines 37-56).

Regarding claim 14, 40, and 41, Drummond teaches the method of claims 1 and 11 wherein the appended information is capable of being rendered by the intended recipient as an icon indicative of authentication (col. 2, lines 37-56).

Regarding claim 15, Drummond teaches the method of claim 11 wherein the endorsement information is capable of being rendered by the intended recipient as a graphical user interface indicative of authentication (col. 2, lines 37-56).

Regarding claim 17, Drummond teaches the method of claim 1 wherein the electronic data comprises an e-mail message (col. 2, lines 23-36).

Regarding claims 22 and 36, Drummond teaches the computer program of claim 20 and 34 wherein the computer readable medium is a client device (col. 2, lines 23-36).

Regarding claims 23 and 37, Drummond teaches the computer program of claim 20 and 34 wherein the computer readable medium is a host device (col. 2, lines 23-36).

Regarding claim 26, Drummond teaches the method of claim 25 wherein the endorsement information is rendered by the intended recipient as an icon indicative of endorsement (col. 2, lines 37-56).

Regarding claim 27, Drummond teaches the method of claim 25 wherein the endorsement information is rendered by the intended recipient as a graphical user interface indicative of endorsement (col. 2, lines 37-56).

Regarding claim 29, Drummond teaches the method of claim 25 wherein the endorsement information is rendered with contents of the electronic data (col. 2, lines 37-56).

Regarding claim 30, Drummond teaches the method of claim 25 wherein the endorsement information is rendered with attributes of the electronic data (col. 2, lines 37-56).

Regarding claim 31, Drummond teaches the method of claim 25 wherein the electronic data comprises an e-mail message (col. 2, lines 37-56).

Regarding claim 43, Drummond teaches the method of claim 1 wherein modifying the electronic data includes appending endorsement information to originally-received electronic data (col. 2, lines 37-56).

Regarding claim 44, Drummond teaches the method of claim 1 wherein modifying the electronic data includes instructing a rendering application that the electronic data represents endorsed communications (Liu, col. 25, lines 1-26, col. 27, line 38 – col. 28, line 3).

Regarding claim 45, Drummond teaches the method of claim 1 wherein modifying the electronic data includes configuring a messaging communication to reflect endorsement by a messaging provider (Liu, col. 25, lines 1-26, col. 27, line 38 – col. 28, line 3).

5. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds, Liu, and Drummond further in view of Mosberger et al., U.S. Patent No. 6,438,597.

Leeds teaches the invention as substantially as claimed including methods and system for handling electronic mail messages (see abstract). Liu teaches the invention substantially as claimed including a method and system for providing secure data transmissions between Internet users (see abstract). Drummond teaches the invention substantially as claimed including techniques for restricting delivery of unsolicited e-mail, commonly known as "spam" (see abstract).

As to claims 4 and 8, Leeds and Drummond teach the method of claim 2.

Leeds and Drummond fail to teach the limitation further including the method of claim 2 wherein the sender is identified by an IP address.

However, Mosberger teaches a system and method for managing accesses to a data service system that supports persistent as well as non-persistent connections (see abstract). Mosberger teaches the use of a sender IP address which identifies the user (col. 7, lines 42-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leeds and Drummond in view of Mosberger to use a sender identified by an IP address. One would be motivated to do so because each sender has a unique IP address.

6. Claims 16, 28, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds, Liu, and Drummond further in view of McBrearty, U.S. Patent No. 6,766,352.

Leeds teaches the invention as substantially as claimed including methods and system for handling electronic mail messages (see abstract). Liu teaches the invention substantially as claimed including a method and system for providing secure data transmissions between Internet users (see abstract). Drummond teaches the invention substantially as claimed including techniques for restricting delivery of unsolicited e-mail, commonly known as "spam" (see abstract).

As to claims 16, 28, and 42, Leeds, Liu, and Drummond teach the method of claims 15, 27, and 40.

Leeds, Liu, and Drummond fail to teach the limitation further including wherein the graphical user interface includes a border indicative of endorsement around contents of the electronic data.

However, McBrearty teaches a method and system for identifying to a user when files being displayed on a client system of a network are cached files (see abstract). McBrearty teaches the use of a color-coded border (col. 2, lines 58-67, col. 3, lines 1-10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leeds and Drummond in view of McBrearty to use a border indicative of endorsement around contents of electronic data so that presentation of the electronic data visually distinguishes endorsed messages from nonendorsed messages.

One would be motivated to do so because it is a way of visually confirming endorsement without the user needing to read any text.

7. Claims 18 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds and Liu further in view of McDonough, U.S. Patent No. 6,714,982.

Leeds teaches the invention as substantially as claimed including methods and system for handling electronic mail messages (see abstract). Liu teaches the invention substantially as claimed including a method and system for providing secure data transmissions between Internet users (see abstract).

As to claims 18 and 32, Leeds and Liu teach the method of claims 1 and 25.

Leeds and Liu fail to teach the limitation further including the method of claims 1 and 25 wherein the electronic data comprises an instant message.

However, McDonough teaches a method of handling a message sent from a sender to a recipient via a network server (see abstract). McDonough teaches the use of electronic data in an instant message.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leeds and Liu in view of McDonough to use an instant message for passing electronic data. One would be motivated to do so because instant messages are quick way to pass data.

8. Claims 21 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds and Liu further in view of Chaney et al., U.S. Patent No. 6,104,990.

Leeds teaches the invention as substantially as claimed including methods and system for handling electronic mail messages (see abstract). Liu teaches the invention substantially as claimed including a method and system for providing secure data transmissions between Internet users (see abstract).

As to claims 21 and 35, Leeds and Liu teach the computer program of claims 20 and 34.

Leeds and Liu fail to teach the limitation further including the computer readable medium as a disk.

However, Chaney teaches automatic identification of significant phrases in a machine-readable document (see abstract). Chaney teaches the use of a disk as a computer readable medium (col. 9, lines 22-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leeds and Liu in view of Chaney to use a disk as a computer readable medium. One would be motivated to do so because it allows for more options to store a computer program.

9. Claims 39 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds, U.S. Patent No. 6,393,465, in view of Liu et al., U.S. Patent No. 6,760,752, further in view of McBrearty, U.S. Patent No. 6,766,352.

Leeds teaches the invention as substantially as claimed including methods and system for handling electronic mail messages (see abstract).

As to claim 39, Leeds teaches the method of a graphical user interface for rendering information associated with electronic data transmitted from a sender to an intended recipient, the graphical user interface rendering the endorsement information to a user of the intended recipient so as to inform the user of the intended recipient that the electronic data has been endorsed (col. 3, line 65 – col. 4, line 7).

Leeds fails to teach the limitation further including where the presentation of the electronic data visually distinguishes endorsed messages from nonendorsed messages.

However, Liu teaches the use of a private title placeholder and visual indicators for secure messages (col. 25, lines 1-26, col. 27, line 38 – col. 28, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leeds in view of Liu to use a presentation of the electronic data that visually distinguishes endorsed messages from nonendorsed messages. One would be motivated to do so because it is an efficient way to let a user know a message is endorsed.

Leeds fails to teach the limitation further including the graphical user interface includes a border indicative of endorsement around contents of electronic data.

However, McBrearty teaches a method and system for identifying to a user when files being displayed on a client system of a network are cached files (see abstract). McBrearty teaches the use of a color-coded border (col. 2, lines 58-67, col. 3, lines 1-10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Leeds and Liu in view of McBrearty to use a border indicative of

endorsement around contents of electronic data. One would be motivated to do so because it is a way of visually confirming endorsement without the user needing to read any text.

Regarding claim 52, Leeds and Liu teach the method, apparatus, computer program, and graphical user interface of claims 1, 19, 20, 25, 33, 34, and 39 wherein modifying the electronic data includes displaying both the endorsed messages and nonendorsed messages in a single display concurrently (Liu, col. 25, lines 1-26, col. 27, line 38 – col. 28, line 3).

Response to Arguments

10. In view of the appeal brief filed on March 7, 2008, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth above.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,725,381 to Smith et al.

U.S. Pat. No. 6,640,301 to Ng.

U.S. Pat. No. 6,584,564 to Olkin et al.

U.S. Pat. No. 6,356,937 to Montville et al.

U.S. Pat. No. 5,937,160 to Davis et al.

U.S. Pat. No. 6,745,936 to Movalli et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AVI GOLD whose telephone number is (571)272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

AMG

/Ario Etienne/
Supervisory Patent Examiner, Art Unit 2157